

REMARKS

The above amendments and following remarks are responsive to the points raised in the final Office Action dated April 30, 2003. By this Amendment, claims 16 and 97 have been amended. Claims 1-98 are all the claims pending in the application. Entry and consideration of this Amendment are respectfully requested.

I. RESPONSE TO REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH

In the Office Action, claims 37, 39, 50, 56 and 65 are rejected under 35 U.S.C. §112, first paragraph, because it is alleged that the specification does not reasonably provide enablement for counting client impressions as claimed. The Examiner states that it is unclear whether only one client impression is being counted for completing all actions (e.g., viewing, printing, saving and transmitting), one client impression is being counted for each action, or some combination thereof. The Applicant respectfully traverses the above rejection for the following reasons.

The Applicants believe that there is sufficient support in the specification to allow one of ordinary skill in the art to make the invention as claimed. The Applicants first direct the Examiner's attention to page 5, line 21 to page 6, line 1 of the specification. In the specification, "impressions" are defined as actions by the client that include viewing of content, printing of content, storing of content and/or transmitting of content to another location. Continuing on page 13, lines 10–15, the specification goes on to explain how the impressions are counted. The specification states the following:

Each time a client views a particular content on the GCC during a session, the client (via the host) logs one impression in relation to that content. If the client views the content and then saves, prints, or e-mails that content to a friend, one impression will be logged for that content provider for each action.

Page 19, line 23 to page 20, line 10 of the specification also gives a detailed explanation about how impressions are counted and credited. The specification states the following:

Once content is accessed, the content provider transmits content, such as a web page, to the client. During this time, the client will have either viewed, or heard, or otherwise had an "impression" of the content. Thus, one impression is credited to the content provider. ...If the client determines that the content is worthy of printing, the client may instruct the host or content to perform a print function. If the content is printed out, the content provider is credited with a second impression. If the client saves the content onto a storage medium, the content provider is credited with an impression as well.

Therefore, the Applicants believe that it is sufficiently clear from a reading of the specification that each action (e.g., viewing, printing, saving and transmitting) will result in an impression being counted and a content provider being credited. Accordingly, the Applicants respectfully request the §112 rejections to claims 37, 39, 50, 56 and 65 be withdrawn.

II. RESPONSE TO REJECTIONS UNDER 35 U.S.C. 102(e)

Claims 1-10, 12-15, 30-36, 38, 44-49, 51-53, 55, 64 and 82-91 are rejected as being anticipated by Angles et al. (U.S. Pat. No. 5,933,811, hereafter Angles). Accordingly, the Applicants propose the following arguments for traversing the rejections noted above.

A. Claims 1-10, 12-15, 30-36, 38, 44-49, 51-53, 55, 64 and 82-91

In the Office Action, the Examiner relies on Angles for anticipating the above claims of the present invention. However, the Applicants respectfully disagree with the Examiner's interpretation of Angles and maintain that Angles fails to disclose each and every element as recited in the claims.

Specifically, Angles fails to disclose the following features: 1) a revenue pool of a plurality of advertisers, sponsors or other revenue sources; 2) determining content provider revenue by dividing a revenue pool by the total number of client impression counted; and 3) a functional host for receiving client impressions. At least one of these features is recited in claims 1, 30, 38, 44, 46-47, 51, 55, 64, 82, and 85 of the present invention.

In the Office Action (page 5), the Examiner states that Angles discloses an advertisement provider that bills a plurality of advertisers (col. 4, lines 3-5) for payment to content provider based on the advertisements viewed by consumers (col. 4, lines 20-22). The money collected is paid to the content providers according to the number of advertisements viewed. (col. 4, lines 43-46). The Examiner states that this "implies" advertisement providers must maintain a revenue pool for the monies collected from the advertisers.

The Applicants respectfully disagree. Angles at col. 4, lines 3-5 actually discloses that advertisers are billed by advertisement providers based on the "actual delivery of the advertisements to a consumer." There is no mention in Angles regarding how often content providers are paid or whether the money collected is stored in a revenue pool. To this end, if content providers were paid each time an advertiser is billed there would be no need for a revenue pool. In fact, you cannot calculate or otherwise determine a finite revenue pool using

the teachings of Angles because revenues are calculated based on a variable number of impressions. In this regard, Angles appears to teach away from the use of the claimed revenue pool.

Col. 4, lines 20-22 of Angles also fails to discuss or imply the use of a revenue pool. Instead Angles teaches only that content providers get paid based on the number of time a consumer accesses their content page. Finally, Col. 4, lines 40-43 discusses a different embodiment of the invention involving an Internet provider. In this embodiment, payment to an Internet provider is made by an advertisement provider based on the number of advertisements viewed by a consumer. Again, there is no mention as to how often payment is made or if revenue from advertisers is collected in a revenue pool.

Based on the foregoing, it logically follows that Angles also fails to disclose dividing such a revenue pool by the total number of client impressions to determine content provider revenue.

In the Office action (page 4), the Examiner relies on col. 3, lines 25-29 and col. 3, line 66-col. 4, line 5 for disclosing the claimed functional host of the present invention. However, at col. 3, lines 25-29 and col. 3, line 66-col. 4, line 5, Angles discloses the use of unique software that is sent to the client to enhance an Internet browser. The software allows for custom advertisements to be merged with electronic documents obtained from a content provider. Angles fails to disclose that the software is used to monitor or receive client impressions. Although Angles states that advertisements are monitored to determine when advertisements are viewed, the monitoring function is described as "another feature of the

invention,” and does not appear to be related to the software (i.e., functional host) sent to the client.

Conversely, using the present invention, content provider revenue is determined and then paid based on an algorithmic ratio of a revenue pool divided by the number of client impressions. The revenue pool is made up of monies received for ad spots sold to advertisers, sponsors or other revenue sources wishing to advertise for a certain period of time. At the end of the advertising period, the total number of impressions is tallied via the functional host for each of the content providers to determine their revenue. Content providers obtain revenue in accordance with the client impressions limited by the revenue in the revenue pool.

Accordingly, claims 1, 30, 38, 44, 46, 47, 64, 82 and 85 are distinguishable over Angles at least for the reasons noted above. Likewise, claims 2-10, 12-15, 31-37, 39, 45, 48-49, 52-53, 65, 81-84 and 86-91 are also distinguishable over Angles based on their dependency on claim 1, 30, 38, 44, 47, 51 and 85, respectively.

III. RESPONSE TO REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 11 is rejected as being unpatentable over Angles. Claims 16-29, 40-43, 57-63 and 66-73 are rejected as being unpatentable over Angles in view of Logan et al. (U.S. Pat. No. 5,721,827, hereafter Logan). Finally, claims 77-81 are rejected under 35 U.S.C §103(a) as being unpatentable over Gerszberg et al. (U.S. Pat. No. 6,044,403, hereafter Gerszberg). Accordingly, The Applicants propose the following amendments and arguments for overcoming the above rejections.

A. Claim 11

In the Office Action (page 6), the Examiner relies on Angles to render obvious all the elements of claim 11. However, as presented in the arguments for overcoming the §102 rejections to claim 1, Angles fails to teach or suggest at least one of the following features:

1) a revenue pool of a plurality of advertisers, sponsors or other revenue sources; 2) determining content provider revenue by dividing a revenue pool by the total number of client impression counted; or 3) a functional host for receiving client impressions. Accordingly, claim 11 would be allowable over Angles based on its dependency from claim 1.

B. Claims 16-29, 40-43

In the Office Action, the Examiner relies on Angles in view of Logan to teach or suggest all the elements as recited in claims 16-29, and 40-43 of the present invention. However, the Applicants maintain that Angles fails to teach or suggest “subdividing the advertising content according to a functional host” sent to a client, as recited in claims 16 (as amended), 40 and 43.

In the Office action, the Examiner relies on Col. 3, lines 25-29 and Col. 13, lines 61-67 for teaching the functional host of the present invention. However, Col. 3, lines 25-29 of Angles teaches the use of unique software that allows the merging of advertisements with content pages. There is no teaching or suggestion in Angles that this software can be used to create a user profile, select specific advertisements and otherwise subdivide advertising content. Additionally, col. 13, lines 61-67 teaches the use of enhanced software in the advertisement provider's computer used to improve server functionality. However, this software does not appear to be related to the software (i.e., functional host) sent to the client's computer describe in col. 3, lines 25-29.

Logan discloses a list of advertising organized by advertiser and subject. The user can use the list to select additional advertising from the list while suppressing others. However, Logan requires the use of a "player" in the form of a computer and other hardware components or equipment as an integral part of its system and methodology of downloading programming and advertising from a host server. To this end, Logan also fails to teach or suggest a functional host that can be used to create a user profile, select specific advertisements and otherwise subdivide advertising content.

Conversely, the present invention utilizes a software host that is embedded, for example, in an electronic page served to the client or free floating over the page. Each client may use the client-side software host to create a user profile, select specific advertising or otherwise distinguish advertising for each specific user.

Accordingly, even if one of ordinary skill in art were to combine the teachings of Angles and Logan, the combination still would not possess all the limitations recited in claims 16, 40, and 43. Likewise, claims 17-29, and 41-42 are also distinguishable over Angles in view of Logan based on their dependency from claim 16, 40, and 43, respectively.

C. Claims 57-63 and 66-73

In the Office Action (page 9), the Examiner relies on Angles in view of Logan for teaching or suggesting all the features recited in above claims. However, the Applicants maintain that Angles in view of Logan fail to teach or suggest the use of a functional host sent to a client for receiving client impressions, which is a feature recited in claims 55 and 64 from which claims 57-63 and 66-73 depend.

In the Office action (page 4), the Examiner relies on col. 3, lines 25-29 and col. 3, line 66-col. 4, line 5 for disclosing the claimed functional host. However, at col. 3, lines 25-29 and col. 3, line 66-col.4, line 5 Angles discloses the use of unique software that is sent to the client to allow custom advertisements to be merged with electronic documents. Angles fails to teach or suggest that the software is used to monitor or receive client impressions.

Moreover, Logan does not appear to overcome the deficiencies noted above in Angles to render obvious claims 55 and 64.

Therefore, claims 55 and 64 are believed to be distinguishable over Angles in view of Logan at least for the reasons noted above. Likewise, claims 57-63 and 65-73 are also believed to be distinguishable over Angles in view of Logan based on their dependency from claims 55 and 64, respectfully.

D. Claims 77-81

In the Office Action, the Examiner relies on Gerszberg for teaching or suggesting all the features recited in the above claims. However, the Applicants maintain that Gerszberg fails to teach or suggest “transmitting a host from a sponsor to a client on a network that can be exchanged with other clients on the network,” as recited in claim 74 and 78 from which the above claims depend, respectively.

Gerszberg at Col. 12, lines 18-48 teaches a service of providing electronic coupons. The electronic coupons are displayed on a touch screen at appropriate times throughout the day as a screen saver. By swiping the smart card, customers can electronically collect the coupons and use them at a store. In the Office Action, the Examiner states that “a merchant is

equivalent to another client on the network.” Therefore, when a client redeems the coupons it is equivalent to the claimed exchange of coupon.

The Applicants respectfully disagree with the Examiner's interpretation. The teachings in Gerszberg require the recipient of a coupon to redeem (i.e., exchange) the coupon off the network or at a merchant location. Conversely, the present invention allows the coupons to be received and exchanged on the same network. Thus, Gerszberg fails to teach or suggest the receipt and exchange of coupons as specifically recited in claims 74 and 78.

Accordingly, claims 74 and 78 are believed to be distinguishable over Gerszberg for at least the reasons noted above. Likewise, claims 76, 76, 77, 80 and 81 are also believed to be distinguishable over Gerszberg based on their dependency on claims 74 and 78, respectively.

CONCLUSION:

In view of the foregoing, Applicants respectfully submit that all of the pending claims are patentable over the prior art of record, and are now in condition for allowance. Thus, allowance of this application is respectfully requested.

AUTHORIZATION:

No fee is due by filing of this paper. However, the Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account 13-4503, Order No. 3835-4002.

Respectfully submitted,
MORGAN & FINNEGAN, .L.L.P.

Date: July 29, 2003

By: Mark D. Pratt
Mark D. Pratt
Reg. No.: 45,794
(202) 857-7887 Telephone
(202) 857-7929 Facsimile
By
Eric S. Wright
Reg. No. 48,045

CORRESPONDENCE ADDRESS:
Morgan & Finnegan, LLP
345 Park Avenue
New York, NY 10154